

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 26

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PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RANDALL A. ADDINGTON, W. ROBERT ADDINGTON and W. ROBERT  
ADDINGTON II

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Appeal No. 2002-1120  
Application No. 09/396,531

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Before ABRAMS, STAAB and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner for appropriate action with regard to the following issues:<sup>1</sup>

- (1) ***Clarification is required as to the status of the amendment after final filed March 6, 2001 (Paper No. 11).***

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<sup>1</sup> A hearing was scheduled for September 17, 2002 on this appeal. That hearing has been vacated, as explained in the notice vacating the hearing (Paper No. 25), to resolve the issues discussed infra.

The advisory action (Paper No. 12) mailed March 21, 2001 is unclear, as the examiner has checked the block indicating that the proposed amendment(s) will not be entered because they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; the note on the bottom of the form, on the other hand, indicates that the amendments to claims 16 and 18 (proposed cancellation) is approved, but that the amendments to claims 22, 23, 25 and 26 present problems. The amendment has not been clerically entered and the examiner has not annotated the amendment (Paper No. 11) with any instructions as to entry or non-entry.

Appellants' brief (Paper No. 16, page 1) assumes that the amendments making a minor change in claim 16 and cancelling claim 18 have been approved, but that the proposed amendments to the other claims have not been approved.<sup>2</sup>

The examiner's answer (Paper No. 17, page 1<sup>3</sup>) indicates that the appellants' statement of the status of amendments after final in the brief is correct, thereby implying that the amendment to claim 16 and cancellation of claim 18 have been entered. The

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<sup>2</sup> We are not aware of any USPTO policy permitting entry of amendments after final in part.

<sup>3</sup> The page numbering on the answer is irregular, in that the first three pages are not numbered and the fourth through sixteenth pages are numbered 3-15, respectively. In referencing pages of the answer herein, we will use the ordinal page number (e.g., the fourth page is page 4, etc.) rather than the page number actually printed on the page.

examiner's inclusion (answer, page 5) of claim 18 in the rejection under 35 U.S.C. § 102(b) as being anticipated by Marineuse, however, suggests that the examiner has not approved the cancellation of claim 18.

In light of the above, a clear statement on the record by the examiner as to whether or not the amendment after final has been entered is required.

**(2) A determination and appropriate action are needed with regard to whether additional independent claims fees are required to cover any or all of claims 2-13**

Claims 1, 16, 19 and 31 are independent claims. Claims 2-4 and 9-12 recite "[t]he bowler's finger pad shield means of Claim 1..." and thus do not appear to be dependent claims, in that they do not incorporate all of the limitations of claim 1, which recites a bowler's finger pad shield comprising a finger pad shield means and means for placing the contact area of the finger pad shield means in contact with the finger pad. Claims 5-8 and 13 likewise recite only "[t]he bowler's finger pad shield means of Claim 1..." in the preamble thereof and thus also appear not to be dependent claims. However, these claims refer to the "means for placing" (not recited in claim 1 as part of the finger pad shield means), thereby rendering both the scope and the dependency status of these claims unclear.

In light of the above, at least claims 2-4 and 9-12 appear to be independent claims. The fee records for this application, however, indicate that appellants have only paid for a total of four independent claims (one in excess of the three included with the basic filing fee). It thus appears to us that appellants are required to pay extra independent claim fees for at least another 7 claims and perhaps another 12 claims. This fee situation should be resolved prior to a decision on the appeal of the rejections of the claims in this application.

***(3) An explanation is required as to the examiner's interpretation of the "means for placing" limitation of, for example, claims 1 and 31 and identification of the structure in Fowble (US. Pat. No. 617,929) which responds to that limitation***

The "means for placing ..." language in claims 1 and 31 appears to us to be an expression of means for performing a function of the type addressed in the sixth paragraph of 35 U.S.C. § 112. Thus, in order to establish a prima facie case of anticipation, the examiner is required to identify the structure disclosed in appellants' specification which corresponds to the "means for placing" limitation, identify the structure of the applied prior art which the examiner believes responds to the means limitation, explain whether the prior art structure is the same as the corresponding structure in appellants' specification and, if not, why it is an equivalent under the sixth paragraph of 35 U.S.C. § 112. The examiner has not done any of this. Instead, the

examiner simply states (answer, page 4) that Fowble shows "a 'means for placing' by slipping the finger into the shield."

**(3) *The "marked examiner's marked copy [sic] of Fowble included with this action" referred to on page 3 of the answer is not attached to the answer and we have been unable to locate a marked copy of Fowble in the file.***

The examiner identifies structure, such as "strap 5" as corresponding to the "limit means" and "raised surface" of claims 9-11 and 27 and "[r]eference 6" as corresponding to the "support means" of claims 12-14. Without the marked copy of Fowble, which presumably includes reference numerals pointing out particular structure in Fowble, it is impossible for us to ascertain what structure the examiner is identifying as responding to these claimed features.

**(4) *An identification of the structure in Marinese (U.S. Pat. No. 3,046,561) which corresponds to each of the recited elements in claims 16, 19, 31 and 32 is required.***

Appellants argue (brief, page 25) that Marinese does not disclose the elements recited in claims 16, 19, 31 and 32 and the examiner has not explained what structure

in Marinense responds to these elements, instead persisting in merely stating that "[c]laims 16, 19, 31 and 32 are clearly shown" (answer, page 5). In making out a prima facie case of anticipation, the burden is on the examiner to point out where each and every recited element or feature is found in the applied prior art.

***(5) Clarification is required as to whether the examiner's remarks about claim 15 on pages 10-11 of the answer constitute an independent basis for rejection of claim 15 under the second paragraph of 35 U.S.C. § 112.***

While the examiner has included claim 15 in the rejection under the second paragraph of 35 U.S.C. § 112 (answer, page 3), the explanation of the rejection does not specifically address claim 15, thereby implying that the basis for the rejection of claim 15 is simply the basis set forth for claim 1, from which claim 15 depends. The response to arguments section of the answer, on the other hand, speaks at great length on pages 10-11 about lack of clarity in the scope of claim 15. Accordingly, clarification is required as to whether this constitutes an independent basis for the rejection of claim 15 as being indefinite.


CONCLUSION

The application is remanded to the examiner for appropriate action with regard to the afore-mentioned issues. This application, by virtue of its "special" status, requires immediate action. MPEP § 708.01. Further, it is important that the Board of Appeals and Interferences be informed promptly of any action affecting the status of the appeal.

REMANDED



NEAL E. ABRAMS  
Administrative Patent Judge



LAWRENCE J. STAAB  
Administrative Patent Judge



JENNIFER D. BAHR  
Administrative Patent Judge

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Appeal No. 2002-1120  
Application No. 09/396,531

Page 8

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